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EXAMINER	
VAN HANDEL, MICHAEL P	

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/882,485	CONNELLY, JAY H.	
	Examiner	Art Unit	
	MICHAEL VAN HANDEL	2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 March 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *104-138* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *104-138* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date. _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is responsive to an Amendment filed 3/03/2009. Claims **104-138** are pending. Claims **1-103** are canceled. The examiner hereby withdraws the previous objections to claims **104**, **109**, **114**, **121**, **125**, **130**, and **135** in light of Applicant's amendments and remarks.

Response to Arguments

1. Applicant's arguments regarding the rejection of claims **114** and **134** under 35 USC 101, filed 3/03/2009, have been fully considered, but they are not persuasive.

Regarding claims **114** and **134**, the examiner notes that Applicant defines that the medium can be a form of storage for data that may include software transmitted or received via modem or communications interface 213 (p. 11, lines 3-10 of Applicant's specification). The specification proceeds to state that the term "machine-readable medium" shall be taken to any medium that is capable of storing data, information or encoding a sequence of instructions for execution by processor 203 and that the term "machine-readable medium" shall be taken to include carrier wave signals. The examiner notes that a claim directed to a signal *per se* does not appear to be a process, machine, manufacture, or composition of matter. The examiner recommends that Applicant amend the specification to remove the phrases "or may be transmitted or received via modem or communications interface 213" (p. 11, lines 3-10) and "carrier wave signals" (p. 11, line 16).

2. Applicant's arguments regarding the Payton reference, filed 3/03/2009, have been considered, but are moot in view of the new ground(s) of rejection.

Claim Objections

1. Claims **104-138** are objected to because of the following informalities:

Referring to claim **125**, the examiner notes that the phrase regarding the second computer system to perform operations is confusing. The limitations following the phrase are a list of operations performed by the second computer system. As such, the examiner recommends that the semi-colon in the phrase "the second computer system to perform operations comprising;" be changed to a colon. The examiner interprets the claim in the Office Action below as though the recommended changes have been made.

Referring to claims **104**, **114**, **121**, **125**, **130**, and **135**, the examiner notes that the amended claim language is confusing. In the first limitation, a portion of "full content" is broadcast to the user. In the second limitation, demand data is received in response to this portion. In the third limitation, a portion of "full further content" is broadcast to the user. In the fourth limitation, further demand data is received in response to this portion. The fifth limitation recites "broadcasting the full content" corresponding to some of the further content descriptors in response to the further demand data; however, "the full content" refers to the "full content" of the first limitation and "the further content descriptors" correspond to the "full further content," as described in the third limitation. The examiner recommends that the last limitation be changed to "broadcasting the full further content" or that the phrase "full further content" of the third limitation be changed to "the full content" to correspond to the first limitation. The

examiner requests that the language of the claims be changed or that the applicant explain the claims in their remarks, since broadcasting a particular content item after receiving demand data in response to content descriptors that correspond to a different particular content item does not appear to be supported by Applicant's specification.

Referring to claims **105-113**, **115-120**, **122-124**, **126-129**, **131-134**, and **136-138**, the claims are objected to in light of the aforementioned independent claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims **114**, **135** are rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter.

Referring to claims **114** and **135**, the claims are directed towards a machine-readable medium; however, the examiner notes that the specification defines that the medium can be a form of storage for data that may include software transmitted or received via modem or communications interface 213 (p. 11, lines 3-10 of Applicant's specification). The specification proceeds to state that the term "machine-readable medium" shall be taken to include carrier wave signals. The examiner notes that a claim directed to a signal *per se* does not appear to be a process, machine, manufacture, or composition of matter. See **MPEP 2106.01** for guidance.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims **104-138** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to claims **104**, **114**, **121**, **125**, **130**, and **135**, the examiner fails to find support in Applicant's specification for the phrase "the content descriptors including only a portion of the full content corresponding to the content descriptors," as currently claimed. Applicant's specification indicates that, at a certain stage in the processing, certain portions of the content can be distributed in order to receive more user feedback. Applicant's specification further states that the further descriptive content includes portions of the content (see p. 15, lines 12-20 of Applicant's specification); however, the examiner fails to find any disclose that the content descriptors include only that portion. Elsewhere in Applicant's specification, content descriptors are described as having metadata, such as titles, actors, etc. for creating tables (Figs. 7-14). The examiner fails to find a scenario in Applicant's specification where the content descriptors include only the portion (movie trailers, etc.) of the video content and nothing else.

Referring to claims **109**, **125**, **126**, and **138**, the examiner fails to find support in Applicant's specification generating demand data transparent to the user in view of the independent claims on which they depend. The demand data of claim 109 refers back to the

"receiving demand data from the client in response to the content descriptors" step of claim 104. This demand data is received in response to the portion of the full content that was broadcast in the previous limitation of claim 104. Applicant's specification states that the step of generating demand data transparent to the user is with respect to the first stage, that is, the stage corresponding to blocks 303-313 in Figure 3 (see p. 14, lines 18-23). The examiner notes; however, that portions of the content are not sent in this stage, but only in the second stage, that is, the stage corresponding to blocks 315-325 in Figure 3 (see p. 15, lines 1-20). The examiner interprets Applicant's claimed broadcasting limitations as occurring within the loop between blocks 315-325 of Figure 3 in light of Applicant's specification, which describes sending a portion of the content in the second stage. As such, the examiner fails to find support for the claims in light of the claims from which they depend.

Referring to claims **105-113**, **115-120**, **122-124**, **126-129**, **131-134**, and **136-138**, the claims are rejected as being dependent on the aforementioned independent claims.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims **104**, **105**, **108-117**, **120**, **121**, **124-132**, **134**, **135**, **138** are rejected under 35 U.S.C. 102(b) as being anticipated by Dunn.

Referring to claims **104**, **114**, and **121**, Dunn discloses a method/machine-readable medium/system, comprising:

- broadcasting content descriptors to a client, the content descriptors including only a portion of the full content corresponding to the content descriptors (new releases trailers are displayed)(col. 6, l. 54-61 & col. 7, l. 59-67);
- receiving demand data from the client in response to the content descriptors (the user adds the program to a customized list of personal favorites stored at the headend)(col. 7, l. 21-29);
- broadcasting further content descriptors to the client in response to the demand data, the further content descriptors also including only a portion of the full further content corresponding to the further content descriptors (the user customized list previews are displayed)(col. 9, l. 59-67 & col. 10, l. 35-44);
- receiving further demand data from the client in response to the further content descriptors (the user orders the program)(col. 7, l. 11-15 & col. 11, l. 29-36); and
- broadcasting the full content to the client corresponding to some of the further content descriptors in response to the further demand data for presentation on a client device (the program is delivered to the user)(col. 11, l. 36-40).

Further referring to claim **121**, Dunn discloses a server coupled to a client, the server having a storage medium and an integrated circuit coupled via a bus including a multi-drop bus, wherein the system is configured to perform the above operations (Fig. 1).

Referring to claims **105** and **117**, Dunn discloses the method/machine-readable medium of claims 104 and 114, respectively, wherein the content comprises video entertainment programming (col. 4, l. 47-52).

Referring to claims **108**, **120**, and **124**, Dunn discloses the method/machine-readable medium/system of claims 104, 114, and 121, respectively, further comprising prioritizing the content in response to the demand data received from the client (col. 7, l. 21-29; col. 9, l. 59-67; & col. 10, l. 35-44) and wherein broadcasting full content comprises broadcasting full content prioritized (col. 7, l. 11-15 & col. 11, l. 29-40).

Referring to claims **109**, **126**, and **138**, Dunn discloses the method/apparatus/medium of claims 104, 125, and 135, respectively, wherein the demand data in response to the content descriptors is automatically generated transparent to the client based on an amount of content consumed by the client (the user interface unit informs the headend to associate the program ID of the added program with the viewer ID in join table 136)(col. 10, l. 25-27) and wherein the further demand data is generated manually by the client (col. 7, l. 11-15 & col. 11, l. 33-35).

Referring to claim **110**, Dunn discloses the method of claim 104, wherein receiving demand data comprises receiving a demand table, wherein the demand table is determined based on rankings of the content descriptors and existing content at a client (col. 7, l. 21-29).

Referring to claim **111**, Dunn discloses the method of claim 104, wherein the content descriptors include metadata to describe the content (col. 5, l. 54-67).

Referring to claim **112**, Dunn discloses the method of claim 104, wherein the received further demand data includes feedback received from the client, the feedback including a demand indicating a level of desirability for the content (col. 7, l. 21-29).

Referring to claim **113**, Dunn discloses the method of claim 104, further comprising broadcasting a content descriptor schedule signal to the client to indicate that a content descriptor file is to be broadcast at a specified broadcast time (col. 10, l. 3-9, 48-56) and wherein broadcasting content descriptors comprises broadcasting content descriptors at the specified broadcast time (col. 10, l. 53-56).

Referring to claims **115** and **129**, Dunn discloses the medium/apparatus of claims 114 and 125, respectively, wherein the demand data is received from the client in a batch (col. 7, l. 24-29 & col. 10, l. 22-26).

Referring to claim **116**, Dunn discloses the medium of claim 114, wherein the demand data received from the client is received staggered, wherein the staggering is based on a last time the client sent feedback to the server (the program is added to the list of favorites at a different time than the previous program was added)(col. 7, l. 22-29).

Referring to claim **125**, Dunn discloses an apparatus comprising:

- a network including a first computer system (headend server) coupled to a second computer system (STB)(Fig. 1), the first computer system to perform operations comprising:
- broadcasting content descriptors to the second computer system, the content descriptors including only a portion of the full content corresponding to the content descriptors (new releases trailers are displayed)(col. 6, l. 54-61 & col. 7, l. 59-67);
- receiving demand data from the second computer system in response to the content descriptors (the user adds the program to a customized list of personal favorites stored at the headend)(col. 7, l. 21-29);

- broadcasting further content descriptors to the second computer system in response to the demand data, the further content descriptors also including only a portion of the full further content corresponding to the further content descriptors (the user customized list previews are displayed)(col. 9, l. 59-67 & col. 10, l. 35-44);
- receiving further demand data from the second computer system in response to the further content descriptors (the user orders the program)(col. 7, l. 11-15 & col. 11, l. 29-36); and
- broadcasting the full content to the second computer system corresponding to some of the further content descriptors in response to the further demand data for presentation on a device associated with the second computer system (the program is delivered to the user)(col. 11, l. 36-40);
- the second computer system to perform the operations comprising;
- generating demand data transparent to a user of the second computer system in response to the received content descriptor to send to the first computer system (the user interface unit informs the headend to associate the program ID of the added program with the viewer ID in join table 136)(col. 10, l. 25-27);
- generating further demand data using manual user inputs in response to the received further content descriptor to send to the first computer system (col. 7, l. 11-15 & col. 11, l. 33-35); and
- presenting the full content (col. 11, l. 38-40).

Referring to claim **127**, Dunn discloses the apparatus of claim 125, wherein the demand data comprises a demand table, wherein the demand table is determined based rankings of

prioritized content based on user interests and existing content at a client (col. 7, l. 21-23; col. 8, l. 9-10; col. 9, l. 59-67; & col. 10, l. 1-9), wherein the demand table is created and updated at the second computer system in response to filtering the prioritized content received from the first computer system (col. 10, l. 16-34).

Referring to claim **128**, Dunn discloses the apparatus of claim 125, wherein the first computer system comprises a server (headend server)(Fig. 1), and the second computer system comprises a client (STB)(Fig. 1).

Referring to claims **130** and **135**, Dunn discloses a method/machine-readable medium, comprising:

- receiving content descriptors at a client from a broadcaster, the content descriptors including only a portion of the full content corresponding to the content descriptors (new releases trailers are displayed)(col. 6, l. 54-61 & col. 7, l. 59-67);
- generating demand data at the client in response to the content descriptors and sending the demand data to the broadcaster (the user adds the program to a customized list of personal favorites stored at the headend)(col. 7, l. 21-29);
- receiving further content descriptors at the client in response to the demand data, the further content descriptors also including only a portion of the full further content (the user customized list previews are displayed)(col. 9, l. 59-67 & col. 10, l. 35-44);
- generating further demand data at the client in response to the further content descriptors corresponding to the further content descriptors and sending the further demand data to the broadcaster (the user orders the program)(col. 7, l. 11-15 & col. 11, l. 29-36); and

- receiving the full content at the client corresponding to some of the further content descriptors in response to the further demand data for presentation on a client device (the program is delivered to the user)(col. 11, l. 36-40).

Referring to claim **131**, Dunn discloses the method of claim 130, further comprising maintaining a demand data table at the client, updating the demand table as content is consumed, and wherein generating demand data comprises using the demand data table (col. 10, l. 1-34).

Referring to claim **132**, Dunn discloses the method of claim 131, further comprising selectively storing the full content according to the demand data table (col. 11, l. 29-40).

Referring to claim **134**, Dunn discloses the method of claim 131, wherein sending the demand data comprises sending the demand table in response to a signal received at the client from the broadcaster (col. 7, l. 24-29 & col. 10, l. 23-34).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims **106**, **107**, **118**, **119**, **122**, **123**, **133**, **136**, **137** are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn in view of Payton (of record).

Referring to claims **106**, **107**, **118**, **119**, **122**, **123**, **133**, **136**, and **137**, Dunn discloses the method/medium/system of claims 104, 114, 121, and 135. Dunn further discloses receiving a list of personal favorites from a user to determine which video content a user might wish to watch

some day (col. 7, l. 21-24). Dunn does not specifically disclose receiving updated demand data indicating which full content has been stored by the client or which full content has been consumed by the client. Dunn further does not specifically disclose creating and updating the demand table based on user behavior of a previous user at the client. Payton discloses a digital information system for delivering virtual on-demand information over digital transport systems. A local filtering system predicts which subscriber might like, and therefore request (see Abstract). Payton makes these predictions by prompting a user to rate programs that has been stored and consumed by the client (col. 6, l. 33-50). Payton further discloses synthesizing the interests of multiple users at a single device and transmitting the collective interests to the server (col. 9, l. 62-67 & col. 10, l. 12-16). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Dunn to include receiving user ratings of stored and consumed content and the collective interests of multiple users using the local device, such as that taught by Payton in order to provide content more meaningful to the viewer (Dunn col. 1, l. 51-53), thereby reducing the number of subscriber requests that must be provided on-demand (Payton col. 3, l. 35-38).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL VAN HANDEL whose telephone number is (571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Kelley/

Supervisory Patent Examiner, Art Unit 2424

MVH